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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,299	12/05/2000	Kenneth H. Falchuk	healre01.012	7848

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EXAMINER

PASS, NATALIE

ART UNIT PAPER NUMBER

3626

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/730,299	FALCHUK ET AL.	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 17 February 2006. Claim 1 has been amended. Claims 1-4 are currently pending.

Specification

2. The objection to the abstract of the disclosure because it exceeds 150 words in length is hereby withdrawn due to the amendment filed 17 February 2006.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Independent claim 1 recites “providing the continuing medical education credit by recording ...” which appears to guarantee the continuing medical education credit to the physician, however dependent claims 3 and 4, which depend from claim 1, recite conditional limitations for provision of the credit. It is unclear how a credit can both be provided and conditionally provided.

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(B) Independent claim 1 recites “providing the continuing medical education credit ... based at least on the comment ...,” however dependent claims 3 and 4, which depend from claim 1, recite “if the first physician passes the examination, providing the continuing medical education credit.” It is unclear whether the credit is based on the comment or on passing the examination.

5. The rejection of claims 1-4 under 35 U.S.C. 112, second paragraph, for being incomplete is hereby withdrawn due to the amendment filed 17 February 2006.

Claim Rejections - 35 USC §101

6. The rejection of claims 1-4 under 35 U.S.C. 101 for non-statutory subject matter is hereby withdrawn due to the amendment filed 17 February 2006.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by Minnesota Medical Association Report on Telemedicine article, September 1996, URL:

<<http://www.mnmed.org/Protected/telemedicine.pdf>>, hereinafter known as Telemedicine, for

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substantially the same reasons given in the previous Office Action (paper number 10052005).

Further reasons appear hereinbelow.

(A) Claim 1 has been amended to include the recitation of “providing the continuing education credit by recording” on lines 9-10.

As per this new limitation, Telemedicine teaches “[o]ther telemedical physician education systems include: the Medical News Network, the Physicians Television Network, and the Pyramed Network, all of which offer continuing medical education credits to physicians (AMA CMS/CME Report A-94)” (Telemedicine; page 4, column 2, paragraph 4; Examiner interprets this to teach the newly added limitation.

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 10052005, section 7, pages 3-4), and incorporated herein.

(B) Claim 2 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 10052005, section 7, pages 3-4), and incorporated herein.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minnesota Medical Association Report on Telemedicine article, September 1996, URL: <http://www.mnmed.org/Protected/telemedicine.pdf>, hereinafter known as Telemedicine, as applied to claims 1 and 2 above and further in view of Abrahamson et al, U.S. Patent Number 5, 002, 491 for substantially the same reasons given in the previous Office Action (paper number 10052005). Further reasons appear hereinbelow.

(A) Claims 3-4 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 10052005, section 9, page 5), and incorporated herein.

Response to Arguments

11. Applicant's arguments filed 17 February 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 17 February 2006.

(A) On page 6 of the remarks filed 17 February 2006, Applicant notes the inclusion of an amended Abstract. Accordingly, Examiner has withdrawn the objection to the abstract of the disclosure.

(B) In reply to Applicant's remarks on page 6 of the amendment filed 17 February 2006, and as a result of the amendment, Examiner has withdrawn the rejection of claims 1-4 for being incomplete under 35 U.S.C. 112, second paragraph.

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(C) On pages 6-7 of Applicant's response filed 17 February 2006 Applicant argues the rejection of claims 1-4 under 35 U.S.C. § 101. As a result of Applicants arguments and the amendment filed 17 February 2006 Examiner is persuaded and accordingly has withdrawn the rejection of claims 1-4 under 35 U.S.C. § 101

(D) Applicant's arguments on pages 7-10 of the response filed 17 February 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 17 February 2006.

At pages 7-10 of the 17 February 2006 response Applicant argues that the features claimed in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including limitations recited in the preamble, and including the newly added limitations of the amendment filed 17 February 2006, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Telemedicine and Abrahamson, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 10052005), and incorporated herein. In particular, Examiner notes that the features of "providing the medical education credit," as recited in the preamble of claim 1 and in the newly added limitation are taught by the applied references (Telemedicine; see at least page 4, column 2, paragraphs 2-6).

With regard to Applicant's argument at page 8, paragraph 2 of the 17 February 2006 response that the Telemedicine reference “discloses *nothing whatever* about using the telecommunications technology to provide continuing medical education credit,” Examiner respectfully disagrees. Examiner interprets Telemedicine’s teachings of “[o]ther telemedical physician education systems include: the Medical News Network, the Physicians Television Network, and the Pyramed Network, all of which offer continuing medical education credits to physicians (AMA CMS/CME Report A-94)” (emphasis added) (Telemedicine; page 4, column 2, paragraph 4) as teaching “providing continuing medical education credit.”

With regard to Applicant's argument at the paragraph bridging pages 8-9 of the 17 February 2006 response that the Telemedicine reference does not teach “performed in the intermediary” Examiner notes that this is not a claimed limitation.

Further, with regard to the same paragraph, Examiner interprets Telemedicine’s teachings of “[t]he Minnesota Health Data Institute (MHDI) health care telecommunications network, MEDNET, officially went on-line in August 1995. ... The purpose of MEDNET [reads on “intermediary”] is to exchange administrative, clinical, and analytical health care information in an efficient, reliable manner ... support the exchange of administrative information ... eligibility data collection and maintenance of specialized ... databases that can be used for performance measurement and improvement studies as well as access to external and public and private databases ...” (Telemedicine; page 22, column 1, paragraph 4 to column 2, paragraph 2) as teaching “providing the information [reads on “comment”] to a medical information specialist

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in the intermediary who is neither the first nor the second physician;" and Telemedicine's teachings of "specialized clinical databases that can be used for performance measurement ...the ability to electronically ... submit authorizations [reads on "comments"]... the ability to verify eligibility" (Telemedicine; page 22, column 2, paragraphs 1-2) as teaching "the information specialist indicating continuing medical education credit for the first physician based at least on the information [reads on "comment"] in a database accessible from the intermediary."

Furthermore, the courts have stated that if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). (See MPEP 2112.02).

With regard to Applicant's argument from paragraph 2 on page 9 to paragraph 3 on page 10 of the 17 February 2006 response, Examiner respectfully notes that the teachings of an intermediary in a consultation between doctors has already been discussed in this Office Action. With regard to the Telemedicine reference's disclosure of methods for giving the credits, and "ways of performing such communications," Examiner respectfully notes that this has also been discussed above.

With regard to Applicant's argument at page 10, last paragraph of the 17 February 2006 response that the combined applied references fail to teach the limitations of dependent claims 3-4, Examiner respectfully disagrees, noting that the teachings of Abrahamson were applied to the limitations that recited providing an examination, receiving answers for the examination, and grading the received answers as recited by dependent claims 3-4 and as analyzed and described in the previous Office Action (paper number 10052005).

Moreover, with respect to Applicant's argument that a *prima facie* case of obviousness has not been established the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 10052005 and present Office Action) have been expressly articulated.

Consequently, it is respectfully submitted that contrary to Applicant's allegations, the features that Applicant disputes are clearly within the teachings of the applied references and that Applicant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

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Conclusion

12. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

June 12, 2006



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER